APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,946	10/30/2003	Ravi Ganesan	3350-30B	6253

29052   7590   12/20/2006
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EXAMINER
OSBORNE, MATTHEW C

ART UNIT	PAPER NUMBER
3694	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/695,946	GANESAN, RAVI
	Examiner	Art Unit	
	Matthew Osborne	3694	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 October 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*32-66*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>*32-66*</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>30 March 2004</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>20031030, 20041115, 20050624</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This is a first office action on the merits for Application 10/695,946.

Claims 1-31 have been cancelled by the applicant.

Claims 32-66 have been added and examined.

Drawings

1.   The drawings are objected to because they are difficult to read. Please see the
Notice of Draftsperson's Patent Drawing Review for details. Corrected drawing sheets
in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid
abandonment of the application. Any amended replacement drawing sheet should
include all of the figures appearing on the immediate prior version of the sheet, even if
only one figure is being amended. The figure or figure number of an amended drawing
should not be labeled as "amended." If a drawing figure is to be canceled, the
appropriate figure must be removed from the replacement sheet, and where necessary,
the remaining figures must be renumbered and appropriate changes made to the brief
description of the several views of the drawings for consistency. Additional replacement
sheets may be necessary to show the renumbering of the remaining figures. Each
drawing sheet submitted after the filing date of an application must be labeled in the top
margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If
the changes are not accepted by the examiner, the applicant will be notified and
informed of any required corrective action in the next Office action. The objection to the
drawings will not be held in abeyance.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

3.   Claims 32-66 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over Claim 15 of U.S. Patent No. 6,678,664 B1.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because they recite means or steps that are substantially the same and that

would have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 32, 37, 38, 43, 44-52, 59-65 are rejected under 35 U.S.C. 102(b) as being

anticipated by Chen et al. (US 5,590,197).

6.   Re Claims 32 and 37, Chen teaches an electronic payment system and method

comprising:

- [Claim 32] receiving, at a central processing point, information identifying a

  purchaser without identifying a payment account for the purchaser (see at least

  Column 6, Lines 48-57, where merchant forwards modified authorization ticket,

  which contains "personal information required" as per Column 4, Line 65);

- processing the received identifying information at the central processing point to

  determine if the purchaser is a registered purchaser (see at least Column 6,

  Lines 48-57);

- transmitting, from the central processing point to a point of purchase, a notice confirming registration, if the purchaser is determined to be a registered purchaser (see at least Column 6, Lines 48-57); and

- receiving, at the central processing point, an instruction for paying for a purchase on behalf of the purchaser (see at least Column 6, Lines 48-57, where request is embedded in encrypted key provided by purchaser and merchant information); and

- directing a payment for the purchase on behalf of the purchaser based on the determination that the purchaser is a registered purchaser and the received instruction for paying for the purchase (see at least Column 5, Lines 48-55).

- [Claim 37] wherein the information identifying the purchaser is received from the point of purchase (see at least Column 6, Lines 48-57).

7.   Re Claims 38 and 43, Chen teaches an electronic payment system and method comprising:

- [Claim 38] a network interface configured to receive information identifying a purchaser without identifying a payment account for the purchaser and an instruction for paying for a purchase on behalf of the purchaser (see at least Figure 1, "Secured Network"); and

- a processor (see at least Figure 1, "Credit Processor") configured (i) to determine if the purchaser is a registered purchaser based on the received identifying information, (ii) to direct transmission of a notice confirming registration to a point of purchase, if the purchaser is determined to be a registered purchaser, and (iii)

to direct a payment for the purchase on behalf of the purchaser based on the determination that the purchaser is a registered purchaser and the received instruction for paying for the purchase (see at least Column 6, Lines 48-57, discussed *supra*).

- [Claim 43] wherein the information identifying the purchaser is received from the point of purchase (See at least Column 6, 48-57).

8.   Re Claims 44-52 and 59, Chen teaches an electronic payment system and method comprising:

- [Claim 44] receiving a communication, transmitted on behalf of a seller to a payment service provider, representing information identifying a purchaser without identifying a payment account (see at least Column 6, Lines 48-57, where merchant forwards modified authorization ticket, which contains "personal information required" as per Column 4, Line 65);

- confirming that the purchaser is registered with the payment service provider based on the represented information (see at least Column 6, Lines 48-57); and

- accepting a request that the payment service provider pay the seller on behalf of the purchaser, based on the confirmation of registration (see at least Column 6, Lines 48-57).

- [Claim 45] transmitting a communication, from the payment service provider, representing a notice of the confirmation of registration (see at least Column 6, Lines 48-57).

- [Claim 46] receiving a communication, transmitted on behalf of other than the seller to the payment service provider, representing second information related to the purchaser (see at least Column 6, Lines 12-26); and

- registering the purchaser based on the represented second information (see at least Column 6, Lines 12-26, "wallet is created by the account servicer");

- wherein the communication representing the first information is received subsequent to the purchaser being registered (see at least Column 6).

- [Claim 47] wherein the represented second information includes an identification of the payment account (see at least Column 6, Line 16, "account information").

- [Claim 48] wherein the received communication representing the second information is transmitted on behalf of the purchaser (see at least Column 6, Lines 12-26).

- [Claim 49] wherein the seller is a first seller, the request to pay is a first request to pay, and further comprising:

- subsequent to the purchaser being registered, receiving another communication, transmitted on behalf of a second seller to the payment service provider, representing third information identifying the purchaser without identifying a payment account (see at least Column 6, Lines 48-57, completed with another "Merchant Processor" as shown in Figure 1);

- further confirming that the purchaser is registered based on the represented third information (see at least Column 6, Lines 48-57, completed with another "Merchant Processor" as shown in Figure 1); and

- accepting a second request that the payment service provider pay the second seller on behalf of the purchaser, based on the further confirmation of registration (see at least Column 6, Lines 27-57, completed with another "Merchant Processor" as shown in Figure 1).

- [Claim 50] transmitting a communication, from the payment service provider, representing a first notice of the confirmation of registration based on the represented first information (see at least Column 6, Lines 48-57); and

- transmitting a communication, from the payment service provider, representing a second notice of the further confirmation of registration based on the represented third information (see at least Column 6, Lines 27-57, completed with another "Merchant Processor" as shown in Figure 1).

- [Claim 51] wherein the first seller and the second seller are the same seller (see at least Column 6, Lines 27-57, completed with the same "Merchant Processor" as shown in Figure 1).

- [Claim 52] wherein the represented first information and the represented third information are the same information (see at least Column 6, Lines 48-57, wherein the information sent is the customer's authorization ticket and merchant embedded information).

- [Claim 59] wherein the communication is received from the seller (see at least Column 6, Lines 48-57).

9.   Re Claims 60-65, Chen teaches an electronic payment system and method comprising:

- [Claim 60] a memory configured to store identifiers for purchasers registered with a payment service provider (see at least Column 6, Lines 12-18, where all "information which might be needed during the payment and authentication process" is stored at the account servicer, inherently requiring a memory); and

- a processor configured to receive a communication, transmitted on behalf of a seller, representing information identifying a purchaser without identifying a payment account, to confirm that the purchaser is registered with the payment service provider based on the represented information and the stored identifiers, and to accept a request that the payment service provider pay the seller on behalf of the purchaser, based on the confirmation of registration of the purchaser (see at least Figure 1, "Credit Processor").

- [Claim 61] wherein the processor is further configured to direct the transmission of a communication, to representing the confirmation of registration (see at least Column 6, Lines 48-57).

- [Claim 62] wherein the information is first information; and

- the processor is further configured to receive a communication, transmitted on behalf of other than the seller, representing second information related to the purchaser, and to direct the storage of the represented second information in association with an identifier for the purchaser (see at least Column 6, Lines 12-26);

- wherein the communication representing the first information is received

  subsequent to the directed storage of the represented second information (see at

  least Column 6).

- [Claim 63] wherein the received communication representing the second

  information is transmitted on behalf of the purchaser (see at least Column 6,

  Lines 48-57, where request is embedded in encrypted key provided by purchaser

  and merchant information).

- [Claim 64] wherein the seller is a first seller; the request to pay is a first request

  to pay;

- the processor is further configured to receive, subsequent to directing the storage

  of the represented second information, another communication, transmitted on

  behalf of a second seller, representing third information identifying the purchaser

  without identifying a payment account, to further confirm that the purchaser is

  registered with the payment service provider based on the represented third

  information and the stored identifiers, and to accept a second request that the

  payment service provider pay the second seller on behalf of the purchaser,

  based on the further confirmation of registration (see at least Column 6, Lines 48-

  57, completed with another "Merchant Processor" as shown in Figure 1).

- [Claim 65] wherein the processor is further configured (i) to transmit a

  communication representing a first notice of the confirmation of registration of the

  purchaser with the payment service provider based on the represented first

  information and the stored identifiers (see at least Column 6, Lines 48-57), and

(ii) to transmit a communication representing a second notice of the further

confirmation of registration of the second seller with the payment service provider

based on the represented third information and the stored identifiers (see at least

Column 6, Lines 48-57, completed with another "Merchant Processor" as shown

in Figure 1).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 33-35, 39-41, 55, 57, and 66 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Chen et al. ('197) in view of Braun (US 3,594,727).

12.   Re Claims 33-35, 39-41, 55, 57, and 66, Chen teaches the system of Parent

Claims 1, 38, and 44, *supra*. Chen also teaches:

- [Claim 33] receiving, at the central processing point, information identifying a

  purchase price for the purchase (see at least Column 4, Lines 18-21);

- transmitting an authorization for the purchase (see at least Column 4, Lines 18-

  21);

- [Claim 39] the network interface is further configured to receive information

  identifying a purchase price for the purchase (see at least Column 4, Lines 18-

  21);

- the processor configured to transmit an authorization for the purchase to the point of purchase (see at least Column 4, Lines 18-21);

- [Claims 34, 40] wherein information identifying the purchase price is received from the point of purchase (see at least Column 4, Lines 18-21).

- [Claims 35, 41] wherein the notice confirming registration and the authorization for the purchase are transmitted as a unitary transmission (see at least Column 6, Lines 48-57).

- [Claim 55] wherein the represented information identifies a price for a purchase by the purchaser from the seller (see at least Column 4, Lines 18-21), and

- transmitting a communication, from the payment service provider to the seller, representing a notice that the purchase is authorized (see at least Column 4, Lines 18-21).

- [Claim 57] the transmitted communication also represents a notice of the confirmation of registration (see at least Column 6, Lines 48-57).

- [Claim 66] wherein the represented information identifies a price for a purchase by the purchaser from the seller (see at least Column 4, Lines 18-21);

- the processor is further configured to transmit a communication representing a notice that the purchase is authorized by the payment service provider (see at least Column 4, Lines 18-21).

Chen does not explicitly teach [Claims 33, 39] processing to determine if the purchase price exceeds a threshold amount or [Claims 33, 39, 55, 66] transmitting an authorization/notice of authorization if the price is determined not to exceed the

threshold amount. However, Braun teaches a credit card banking system in which "[t]he peripheral stations then accept or reject requests for purchases on credit, rejection to occur if a credit limit has been exceeded, payment is overdue, or the like" (Column 4, Lines 6-9). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the "credit limit" feature of Braun into the electronic payment system and method of Chen in order to reduce the credit risk of the unavailable funds to the Credit Processor and the burden of overdrawn funds fees to the User.

13.   Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. ('197) in view of Braun ('727) as applied to Claim 55 above, and further in view of Egendorf (US 5,794,221).

14.   Re Claim 56, Chen in view of Braun teaches a relationship between the purchase price and available purchaser funds (Column 4, Lines 6-9, "credit limit"). Chen in view of Braun does not teach a relationship between the purchase price and a threshold limit. However, Egendorf teaches an internet billing method in which "one account will be used for certain transactions, and a different account for other transactions, for example, a telephone account for transactions less than $5.00, and a bank account for transactions of at least $5.00" (Column 6, Lines 19-22). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the account threshold relationship of Egendorf into the electronic payment system and method of Chen in view of Braun in order to allow a user to debit funds from various accounts based upon the cost of the transaction.

15.   Claims 53, 54, and 58 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chen et al. ('197) in view of Loiacono (US 5,293,422).

16.   Re Claims 53 and 54, Chen teaches the method of Parent Claim 49, *supra*.

[Claim 53] Chen does not specifically disclose the first information identifying the

purchaser including only a first type of information and a third information identifying the

purchaser including the first type and a second type of information. [Claim 54] While

Chen discloses an identifying information including a purchaser's authorization ticket

(the claimed "second type identifying information"), Chen does not specifically disclose

the first type of information being limited to one or more of a name, an address, a

driver's license number and a passport number of the purchaser. However, Loiacono

discloses a usage control system for computer software in which "the user enters his or

her identifier (e.g., his or her last name), and the program compares that identifier with

the registered user file to determine if the user has or has not been previously

registered" (Column 5, Lines 60-64). It would therefore be obvious to one of ordinary

skill in the art at the time of invention to incorporate the registered user identification

process of Loiacono into the electronic payment system and method of Chen in order to

create a system which allows various methods of identification of the user, without the

transmission of an account number, for use with merchants of various trustworthiness or

transaction security requirements.

17.   Re Claim 58, Chen teaches the method of Parent Claim 44, *supra*. While Chen

discloses an identifying information including a purchaser's authorization ticket, Chen

does not specifically disclose the information identifying the purchaser including a first

portion and a second portion, the first portion including at least one of a name, an

address, a driver's license number and a passport number of the purchaser, and the

second portion including other than the name, the address the driver's license number

and the passport number of the purchaser. However, Loiacono discloses a usage

control system for computer software in which "the user enters his or her identifier (e.g.,

his or her last name), and the program compares that identifier with the registered user

file to determine if the user has or has not been previously registered" (Column 5, Lines

60-64). It would therefore be obvious to one of ordinary skill in the art at the time of

invention to incorporate the registered user identification process of Loiacono into the

electronic payment system and method of Chen in order to send an extra identification

in the identification information which would allow for additional verification of the

registered user involved in the transaction.

18.   Claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Chen et al. ('197) in view of Matsuura et al. (US 5,315,511 A).

19.   Re Claims 36 and 42, Chen teaches the limitations of Parent Claims 32 and 38,

supra. Chen discloses a method and system that directs payment for the purchase on

behalf of the purchaser automatically to immediately pay for the purchase (see at least

Column 5, Lines 42-60, the completion of the transaction by conducting "Credit

Authorization" articulated in Figure 1). Chen does not explicitly disclose the received

instruction for paying for the purchase on behalf of the purchaser being one of an

instruction to immediately pay for the purchase and an instruction to subsequently pay

for the purchase, and if the instruction is to immediately pay, to automatically direct

payment. However, Matsuura discloses "dealing data compris[ing] data regarding a time requested by the user for transacting ... payment of money [at] the requested branch" (see at least Claim 5). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the delayed payment request capability of Matsuura into the electronic payment system and method of Chen in order to allow the purchaser more flexibility in paying for goods and services supplied by the merchant and to "improve an efficiency of the use of funds" (Matsuura, Column 2, Line 56).

Conclusion

20.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knight et al. (US 5,383,113) discloses a system and method for electronically providing customer services.

Elgamal (US 5,671,279) discloses electronic commerce using a secure courier system.

Pedersen (US 5,739,511) discloses a method for effecting an electronic payment transaction having a variable number of payment units.

Mullins et al. (US 6,142,368) discloses a prepayment wristband and computer debit system.

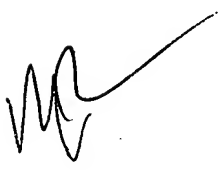Najor et al. (US 6,183,017 B1) discloses a telephone calling card coupon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew C Osborne
Examiner
Art Unit 3694

ELLA COLBERT
PRIMARY EXAMINER